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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/857,831

09/07/2001

Kai K.O. Bar

27428/37457

2913

7590

12/03/2003

Marshall O'Toole Gerstein
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EXAMINER

PADGETT, MARIANNE L

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 12/03/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,831

Applicant(s)

Bar et al

Examiner

M.L. Padgett

Group Art Unit

1762

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 7/08/03

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other non-compliant amendment (to specification only)

Office Action Summary

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1. It is noted that the amendments to the specification on page 6 and 7 are non-compliant, but as the changes are discussed on page 7 in the remarks, and the examiners agrees that 1.0 m is an obvious error, thus encompasses an obvious correction (although applicant technically should supply a prior art reference supporting this change), the prosecution of the claims will not be delayed by waiting for the correction to the amendment to the specification.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8 and 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatter et al (6,406,757 B1 or WO 99/41323), in view of Hirabayashi et al (PN 4,900,583 discussed in section 4 of Paper No. 4 mailed 4/28/2003).

It is noted that the US Patent is considered to provide a translation for the PCT publication WO 99/41,323 to Blatter et al, and that the data therefore of August 19, 1999 is

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between applicants' 371 filing date of October 21, 1999 and their German priority of December 10, 1998, hence to remove these references, a certified translation of the German priority document may be affective.

Blatter et al (757 and WO) teach depositing powder finishes that are cured with near infrared (NIR) radiation, where the powder composition may include resins; pigments; fluid control agents; and further lacquer additives; may be sprayed from supercritical solutions or "non-aqueous dispersion" processes; or may be applied from aqueous dispersions or "powder slurries", where the NIR is advantageously used to remove water (abstract; column 2, lines 16-62; and column 4, lines 25-40 and 53-65). Substrates may be passed before NIR sources of 750-1200 nm that are employed (times of 2-400 sec to cure or 1-30 sec), including halogen lamps, which may achieve light source temperatures of for example 3500 K (column 5, lines 1-20). Substrates to be coated include wood or derivative timber product surfaces or paper, where the technique of Blatter et al is taught for high speed coating, for example $<50 \text{ m/min} \approx 0.83 \text{ m/sec}$ (column 5, lines 26-50).

While Blatter et al do not discuss the need to cure/remove liquid/dry their wood or paper substrates before warpage or detrimental bleeding-in may occur, they teach a "high speed" process for their coating technique, which includes deposition techniques employing liquids, i.e. dilution fluids, hence one of ordinary skill in the art would have expected the time between deposition and NIR treatment which removes liquid (i.e. dries) and cures to be within the functional times claimed in order to achieve exemplary coating speed as taught. Hirabayashi et al, as previously discussed is cumulative to these teachings for its analogous NIR drying technique and supplies further motivation for treatment speeds for paper substrates which

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overlap with substrates of Blatter et al (757 or WO), and provide further motivation for claimed timing as paper and wood are old and well known to have similarly porous properties.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blatter et al (757 or WO), in view of Hirabayashi et al as applied to claims 1-8 and 10-19 above, and further in view of Kimble and Josefsson et al, as applied in section 6 of Paper No. 14.

5. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Other art of interest for NIR treatment of coated wood products include Blatter et al (6,432,491 B1 and 6,506,458 B1); Neckers (6,200,646 B1) et al, Bendix et al (2003/0100667 A1) and Sedlmeyr et al (6,436,485 B1).

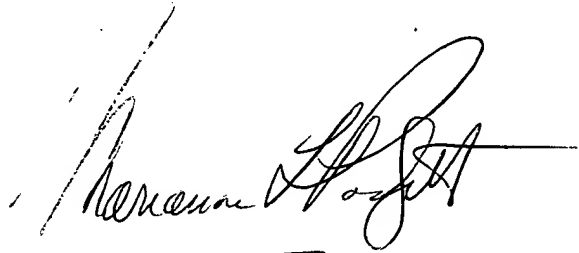
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication from the examiner should be directed to M. L. Padgett whose telephone number is (703) 308-2336 until 12/9/03, then will be (571) 272-1425. The examiner can generally be reached on Monday-Friday from about 8:30 a.m. to 4:30 p.m.; and fax phone numbers are (703) 872-9306 (all official).

M.L. Padgett/dh
November 28, 2003



**MARIANNE PADGETT
PRIMARY EXAMINER**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 15

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 7/28/03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. **Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.**

THE FOLLOWING CHECKED (X) ELEMENTS(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
- ☒ A. Amended paragraph(s) do not include markings. *no additions or deletions are marked, for p. 6 + 7 amendments.*
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all claims (incl. withdrawn claims)
- ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH time limit is not extendable**.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE)

July 22, 2003 (rev.)

MARIANNE PADGETT
PRIMARY EXAMINER